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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,799	11/02/2001	John Joseph King	LF 102US	3842

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EXAMINER	
DIVECHA, KAMAL B	
ART UNIT	**PAPER NUMBER**
2151	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/002,799	KING ET AL.	
	Examiner	Art Unit	
	KAMAL B. DIVECHA	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Arguments

Claims 21-49 are pending in this application.

Claim Rejections - 35 USC § 112

The 35 USC 112, first paragraph rejections presented in the prior office action has been withdrawn.

Applicant's arguments with respect to claims 21-49 filed on December 09, 2005 in the request for continued examination (RCE) have been considered but are moot in view of the new ground(s) of rejection (please see the detailed action below).

DETAILED ACTION

Claims 21-49 are presented for re-examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 21-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of co-pending application no. 10/004,318.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-20 of the co-pending applications discloses all the limitations of the claims 21-49 of instant application.

For example: claim 1 of co-pending application contains every element of claim 21 of the instant application and as such anticipates claim 1 of the instant application, claim 22-23 of instant application contains every element of claims 5-6 of co-pending application and as such anticipates claim 22-23 of the instant application, and so on.

2. Claims 21-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-40 of co-pending application no. 10/000,939.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 21-40 of the co-pending application at least discloses all the limitations of the independent claims in claims 21-49 of instant application.

For example: claim 21-23 of co-pending application contains every element of claim 21-23 of instant application, and as such anticipates claim 21-23 of the instant application, and so on.

3. Claims 21-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of co-pending application no. 10/307,121.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-20 of the co-pending application at least discloses all the limitations of the independent claims in claims 21-49 of instant application.

For example: claim 1-3 of co-pending application contains every element of claim 21-22 of instant application, and as such anticipates claim 21-22 of the instant application, and so on.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 21-22, 24-27 and 29-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Santoro et al., (hereinafter Santoro, U. S. Patent No. 6,724,403 B1).

As per claim 21, Santoro discloses a method of enabling the display of a picture file on a cellular telephone (col. 1 L10-15, col. 4 L33-55, col. 5 L13-22, col. 7 L17-25), said method comprising the steps of:

- receiving said picture file at said cellular telephone (col. 9 L34-42, col. 22 L1-20, col. 14 L54-56);

- simultaneously displaying a plurality of picture files on a display of said cellular telephone (col. 8 L35-64, fig. 4 and col. 10 L44-65);

- enabling a user to change information displayed with said picture file of said plurality of picture files by way of a user interface on said cellular telephone (col. 17 L20-24, col. 22 L50-67);

- providing a selection option associated with said picture file when said picture file is displayed on said cellular telephone (col. 9 L24-33, L42-56); and

- enabling access by said user, remote from said cellular telephone by way of a webpage for a user associated with a wireless service provider for said cellular telephone, to said plurality of picture files and said information which has been changed (col. 23 L1-18, col. 23 L. 60-67).

As per claim 22, Santoro discloses the process wherein said step of receiving said picture file at said cellular telephone comprises receiving said picture file by way of a wireless link of a telecommunications network (col. 11 L15-32, fig. 27, col. 24 L3-13 and col. 15 L51-64).

As per claim 24, Santoro discloses the process of storing said picture file on said cellular telephone (fig. 15 item #1506, fig. 17 item #1734 and col. 17 L30-39).

As per claim 25, Santoro discloses the process wherein the step of providing a selection option comprises providing a selection box associated with said picture file which can be selected by a user (col. 10 L14-22, col. 17 L20-25 and col. 14 L48-54).

As per claim 26, Santoro discloses a method of enabling the display of a picture file on a cellular telephone, said method comprising the steps of:

- storing a plurality of picture files on said cellular telephone (fig. 16 item #1502, fig. 17 item #1734, fig. 19 item #1918, fig. 2 item #100, item #122 and col. 9 L57-61);

- simultaneously displaying a plurality of picture files on a display of said cellular telephone (col. 8 L35-64, fig. 4 and col. 10 L44-65);

- enabling a user to change information displayed with said picture file of said plurality of picture files by way of a user interface on said cellular telephone (col. 17 L20-24, col. 22 L50-67);

- providing a selection option associated with said picture file when said picture file is displayed on said cellular telephone (col. 17 L20-25 and col. 14 L46-54);

- enabling a user to designate said selection option while said picture file is displayed on said cellular telephone (col. 17 L20-25 and col. 14 L46-54); and

- enabling access by said user, remote from said cellular telephone by way of a webpage for a user associated with a wireless service provider for said cellular telephone, to said plurality of picture files and said information which has been changed (col. 23 L1-18, col. 23 L. 60-67).

As per claim 30, Santoro discloses the process of enabling a user to enlarge said picture file (col. 9 L1-11, col. 9 L42-55).

As per claim 31, Santoro discloses a method of enabling the display of a picture file on a cellular telephone, said method comprising the steps of:

- simultaneously displaying a plurality of picture files on a display of said cellular telephone (col. 8 L35-64, fig. 4 and col. 10 L44-65);

- enabling a user to change information displayed with said picture file of said plurality of picture files by way of a user interface on said cellular telephone (col. 17 L20-24, col. 22 L50-67);

- providing a selection option associated with said picture file when said picture file is displayed on said cellular telephone (col. 17 L20-25 and col. 14 L46-54);

- enabling a user to designate said selection option while said picture file is displayed on said cellular telephone (col. 17 L20-25, fig. 4 and col. 14 L46-54);

- enabling a user to enlarge said predetermined picture file (col. 9 L1-11, col. 9 L42-55); and

- enabling access by said user, remote from said cellular telephone by way of a webpage for a user associated with a wireless service provider for said cellular telephone, to said plurality of picture files and said information which has been changed (col. 23 L1-18, col. 23 L. 60-67).

As per claim 32, Santoro discloses the process wherein the step of displaying a picture file on a cellular telephone comprises a thumbnail of said picture file (col. 8 L57-67, fig. 4 and col. 9 L1-24).

As per claim 33, Santoro discloses the process wherein said step of enlarging said picture file comprises a step of displaying said picture file as a window on a display of said cellular telephone (col. 8 L1-15).

As per claim 35, Santoro discloses a method of presenting said picture file having a designated option according to a user selectable function (col. 9 L1-56 and col. 17 L20-25).

As per claim 36, Santoro discloses a method of enabling the display of a picture file on a cellular telephone, said method comprising the steps of:

- storing a plurality of picture files on said cellular telephone (fig. 16 item #1502, fig. 17 item #1734, fig. 19 item #1918, fig. 2 item #100, item #122 and col. 9 L57-61);

- simultaneously displaying a plurality of picture files on a display of said cellular telephone (col. 8 L35-64, fig. 4 and col. 10 L44-65);

- enabling a user to change information displayed with said picture file of said plurality of picture files by way of a user interface on said cellular telephone (col. 17 L20-24, col. 22 L50-67);

- providing a plurality of selection options, each said selection option being associated with a picture of said plurality of picture files (col. 17 L20-25 and col. 14 L46-54);

- enabling a user to designate each said selection option associated with plurality of picture files (col. 17 L20-25, fig. 4 and col. 14 L46-54);

- enabling access by said user, remote from said cellular telephone by way of a webpage for a user associated with a wireless service provider for said cellular telephone, to said plurality of picture files and said information which has been changed (col. 23 L1-18, col. 23 L. 60-67).

As per claim 41, Santoro discloses a cellular telephone capable of displaying a picture file (fig. 2 item #100 and col. 7 L17-25), said cellular telephone comprising:

- a control circuit (fig. 2 item #104);

- a memory coupled to said control circuit and storing a plurality of picture files (fig. 2 item #124, 122 and col. 9 L57-61);

- a user interface coupled to said control unit and enabling the user to access said picture files, said user interface enabling a user to change information displayed with a picture file (fig. 2 item #126, col. 24 L15-34);

- a display coupled to said control circuit and displaying said picture file with said plurality of picture files and a selection option associated with said picture file (fig. 2 item #110, fig. 4 and col. 9 L1-56); and

- a webpage associated with a wireless service provider for said cellular telephone, said webpage enabling access by said user, remote from said cellular telephone, to said picture file and said information which has been changed (col. 9 L1-65, fig. 27, col. 22 L1-56, col. 23 L1-19, L60-67).

As per claim 43, Santoro discloses a cellular telephone further comprising an icon on said display, said icon enabling access to said picture file when said icon is selected (col. 8 L1-28 and col. 6 L52-59).

As per claims 27, 29, 34, 37-40, 42 and 44-49, they do not teach or further define over the limitations in claims 21-22, 24-26, 30-33, 35-36, 41 and 43. Therefore, claims 27, 29, 34, 37-40, 42 and 44-49 are rejected for the same reasons as set forth in claims 21-22, 24-26, 30-33, 35-36, 41 and 43.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 23 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Santoro et al., (hereinafter Santoro, U. S. Patent No. 6,724,403 B1) in view of Rudy et al. (U. S. Patent No. 6,360,252 B1).

As per claim 23, Santoro does not explicitly disclose the process of receiving said picture file at said cellular telephone as an attachment to an email.

Rudy, from the same field of endeavor, explicitly discloses the method wherein client machine (read as mobile telephone, col. 3 L39-42) receives the client version of email with descriptor of attachment (attachments contain images, text, video, multimedia documents, etc, col. 1 L25-28: read as receiving image file as attachment to an email, fig. 1 item #20 and #12 and col. 7 L49-53; col. 1 L64-67 to col. 2 L1-10).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to incorporate the teaching of Rudy as stated above with Santoro in order to receive the picture file as an attachment to an email.

One of ordinary skilled in the art would have been motivated because the technique would have used where there is a low bandwidth connection between the server and a users mobile device, where there is a high latency connection or where there is a unreliable or intermittent connection. In addition, the technique would have been advantageous because it would have been used where the client machine or a mobile telephone is not adequate to render most attachments due to storage limitations or due to inadequate output capabilities, such as small display or display with inadequate resolution (Rudy, col. 4 L49-61).

As per claim 28, it does not teach or further define over the limitations in claim 23. Therefore, claim 28 is rejected for the same reasons as set forth in claim 23.

Additional References

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see also PTO-892 dated 02/18/05).

a. Yoshioka, U. S. Patent No. 6,839,068 B2.

b. Nagahara et al., U. S. Patent No. 6,687,382 B2.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kamal Divecha
Art Unit 2151
March 23, 2006.

ZARNI MAUNG
SUPERVISORY PATENT EXAMINER